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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,682	10/31/2001	Akihiro Yoshitani	CANO:039	2566

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EXAMINER	
HUNTSINGER, PETER K	

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
12/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail@rkmlegalgroup.com

Office Action Summary	Application No.	Applicant(s)	
	10/016,682	YOSHITANI ET AL.	
	Examiner	Art Unit	
	Peter K. Huntsinger	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6,15 and 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6,15 and 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/14/09 have been fully considered but they are not persuasive.

The applicant argues on page 2 of the response in essence that: Misawa '382 and Kim '937 do not disclose a controller that controls the first or second producer and the processor to covert the input image data either with or without white data added when the user instructs through the selector to select either the facsimile transmission or the email transmission.

a. Misawa '382 discloses a controller (CPU 11 of Fig. 1, col. 3, lines 19-35) that controls the first (facsimile unit 80 of Fig. 1, col. 3, lines 19-35) or second producer (email transmission unit 17 of Fig. 1, col. 3, lines 19-35) and the processor to covert the input image data without white data added when the user instructs through the selector to select email transmission (col. 5, lines 7-10, read image data is compressed and stored in RAM 13). Kim '937 discloses a processor that converts input data with white data added when the user instructs facsimile transmission (col. 3, lines 58-63, in order to compensate for the difference between the transmission size and the original document size, white pixels are added). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See

In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues on pages 2 and 3 of the response in essence that:
The combination would have taught adding white data for all image data when white data is needed regardless of how the image data is to be transmitted.

b. Kim '937 discloses facsimile transmission but is silent in regards to electronic mail transmission. Because Kim '937 teaches adding white pixels for only facsimile transmission (to compensate for the difference between the original image size and the transmission or paper size), the reference does not have to expressly state that this process would not be applied to an electronic mail transmission, or any other transmission method. White pixel data is not commonly added to electronic mail data because electronic mail data is not regularly formatted to a paper size and printed like the case of facsimile data (i.e. a facsimile is stored as a set number of pages whereas an email is stored according to data size). Therefore, the combination of Misawa '382 and Kim '937 teaches adding white pixel data to an image for facsimile transmission but not adding white pixel data for electronic mail transmission.

The applicant argues on page 4 of the response in essence that:
It is logical to send the image data with added white data regardless of whether the image data is transmitted through facsimile or email.

c. Kim '937 teaches adding white pixels for facsimile transmission (col. 3, lines 58-63, in order to compensate for the difference between the transmission size and the original document size, white pixels are added). Neither Misawa '382 nor Kim '937 provide any suggestion that adding white pixel data to electronic mail image data is possible or preferable.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 6, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa '382 in view of Kim '937.

Referring to **claims 1, 15, and 16**, Misawa '382 discloses an image processing apparatus (composite communication apparatus 10 of Fig. 1, col. 3, lines 19-35) comprising:

an inputter configured to input image data representing an image (image reading unit 15 of Fig. 1, col. 3, lines 19-35);

a processor configured to convert the image data input by said inputter with no white data added to the image data input by said inputter (col. 5, lines 7-10, read image data is compressed and stored in RAM 13)

a first producer configured to produce data for transmission by facsimile based on the image data input by said inputter (facsimile unit 80 of Fig. 1, col. 3, lines 19-35);

a second producer configured to produce data for transmission by electronic mail based on the image data input by said inputter (email transmission unit 17 of Fig. 1, col. 3, lines 19-35);

a selector configured to select a facsimile transmission or an electronic mail transmission based on an instruction by a user (S01 of Fig. 3, col. 4, lines 45-51, electronic mail transmission unit or facsimile transmission unit is selected); and

a controller configured to control said first and second producers, and said processor depending on selection by said selector (CPU 11 of Fig. 1, col. 3, lines 19-35),

wherein said controller controls said first producer to produce the data based on the image data to which the white data is added by said processor in a case where said selector selects the facsimile transmission (S58 and S82 of Fig. 6, col. 6, lines 34-36, 59-62), and

wherein said controller controls said processor to convert the image data input by said inputter with no white data added and said second producer to produce the data based on the image data to which no white data is added by said processor in a case where said selector selects the electronic mail transmission (S62 and S78 of Fig. 6, col. 6, lines 36-39, 42-46).

Misawa '382 does not disclose expressly altering the size of the image to a predetermined image size if the image is to be sent by facsimile.

Kim '937 discloses a processor configured to convert the image data input by an inputter with white data added to the image data input by said inputter, adding white data changing the size of the image to a standardized size according to facsimile standards (col. 3, lines 58-63, in order to compensate for the difference between the transmission size and the original document size, white pixels are added);

a controller configured to control said said processor in a case where the image represented by the image data is smaller than the predetermined size and is not in the standardized size (col. 3, lines 58-63, in order to compensate for the difference between the transmission size and the original document size, white pixels are added); and

wherein said controller controls said processor to convert the image data input by said inputter with the white data added and said first producer to produce the data based on the image data to which the white data is added by said processor in a case of facsimile transmission (col. 3, lines 58-63, in order to compensate for the difference between the transmission size and the original document size, white pixels are added)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add white pixels to an image to reach a predetermined image size when the image is sent via facsimile. The motivation for doing so would have been compensate for the difference between the original image size and the transmission or paper size. Further, there would be no reason to add white pixel data to electronic mail data as electronic mail data is not regularly formatted to a paper size and printed like the case of facsimile data (i.e. a facsimile is stored as a set number of pages whereas

an email is stored according to data size). Therefore, it would have been obvious to combine Kim '937 with Misawa '382 to obtain the invention as specified in claim 1.

Referring to **claim 2**, Misawa '382 discloses wherein said inputter inputs the image data from a reader which reads the image and generates the image data based on the image (image reading unit 15 of Fig. 1, col. 3, lines 19-35).

Referring to **claim 3**, Misawa '382 discloses wherein said inputter inputs the image data from a detachable memory (image reading unit 15 of Fig. 1, col. 3, lines 19-35). Misawa '382 discloses that the scanner can be separate from the composite communication apparatus (col. 7, lines 31-52). It is inherent that the scanner has memory for receiving image data. The scanner can be detached from the system because it is a separate device, therefore the image reading unit 15 is a detachable memory.

Referring to **claim 6**, Misawa '382 discloses wherein said controller restricts operations of said first and second producers according to a predetermined condition (S56 of Fig. 6, col. 6, lines 13-17).

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misawa '382 and Kim '937 as applied to claim 1 above, and further in view of Morigami '934.

Referring to **claim 5**, Misawa '382 discloses wherein said controller controls said first producer and said second producer but does not disclose expressly using different gamma values for producing the data.

Morigami '934 discloses different gamma values in producing data for facsimile and monitors (col. 9, lines 59-67, typical gamma coefficient is 0.45 for CRT and 0.65-0.8 for a facsimile machine).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce an image for facsimile transmission with a different gamma value than producing an image for email. The motivation for doing so would have been to utilize typical gamma values in producing the images to obtain accurate images. Therefore, it would have been obvious to combine Morigami '934 with Misawa '382 and Kim '937 to obtain the invention as specified in claim 5.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625